

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application)	
)	Confirmation No.: 1644
Inventors: Thomas BRENNAN et al.)	
)	Art Unit: 1637
Application No.: 10/602,998)	
)	Examiner: Christopher M. Babic
Filed: June 23, 2003)	
)	
Title: Method and apparatus for performing large)	Customer No. 021971
numbers of reactions using array assembly)	

REQUEST FOR SUPERVISORY REVIEW

OR

PETITION TO THE GROUP DIRECTOR UNDER 37 C.F.R. §1.181

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request that the amendment filed on April 24, 2006 (after the final office action) be entered in the above referenced application.

The claimed invention concerns a solid support that comprises primers for performing polynucleotide amplification reactions. In response to a non-final Office Action, Applicants amended the claims to specify that the primers that are comprised in Applicants' solid support are releaseable before, during or after an amplification reaction. The Examiner issued a Final Office Action citing U.S. patent 5,700,642 to Monforte, and asserting that Monforte's patent teaches "primers that can be cleaved after amplification".

Applicants' representative Albert P. Halluin, held a telephonic interview with Examiner Christopher Babic and Primary Examiner Kenneth Horlick to discuss the claims. During the

Interview Summary, Kenneth Horlick describes that “Claims 1 and 2 were discussed with respect to the disclosure of Monforte relating to immobilized sequences adapted to be released before, during or after amplification. Examiner explained to Applicants’ attorney that Monforte taught releasable sequences after amplification.” Pursuant to the Interview, Applicants submitted an amendment and response to the Final Office Action wherein the scope of the claims was narrowed by limiting Applicants’ primers to be released before the amplification reaction by deleting the terms “during or after.

Subsequently, the Examiners issued an Advisory Action stating that the proposed amendments

1. “raise new issues that would require further consideration and/or search”;
2. “they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal”;
3. “for the purposes of appeal, the proposed amendment(s) will not be entered.”; and
4. “The request for reconsideration has been considered but does not place the application in condition for allowance because: The proposed amendment of Claim 2 which deletes --during or after—significantly changes the scope of the claim and would require further search and consideration on the part of the Examiner. At present, Claim 2 encompasses immobilized sequences adapted to be released before, during or after amplification. A previous search of the prior art revealed a reference (Monforte et al.) that taught immobilized sequences adapted to be released after amplification. The previously applied reference clearly encompassed the instant alternative claim language. Further examination would be needed to consider prior art teaching immobilized sequences adapted to be released before amplification.”

Applicants disagree with the Examiners’ reasons for non-entry of the amendment for the following reasons.

First, Applicants submit that the amendment, which limits Applicants’ primers to be released before an amplification reaction, was made pursuant to the Examiners’ suggestion given in the Final

Office Action and during the Interview to the effect that Monforte's primers differ from Applicants' primers by their ability to be released after the amplification reaction.

Second, Applicants disagree with the Examiners' statement that the amendment raises issues that require a further search. A complete search that produces a patent or publication that describes primers that can be released before, during or after an amplification reaction would include patents or publications that describe primers that can be released before an amplification reaction. Therefore, deleting "during or after" from the claim would not require an additional search.

Third, Applicants' amendment narrows the scope of the claims, and contrary to the Examiners' opinion, the amendment does indeed reduce the issues for appeal by narrowing the scope of the claims.

In light of the remarks set forth above, Applicants believe that the amendment filed in response to the Final Office Action should be entered. Applicants respectfully request that the Director grant Applicants their request for supervisory review or in the alternative consider the foregoing as a petition under 37 C.F.R. § 1.181(3).

The Director is authorized to charge any fees that may be required in connection with this submission, including petition fees and extension of time fees, and to credit any overpayments to Deposit Account No. 23-2415 (Attorney Docket No. 28690-705.302).

Respectfully submitted,

Date: May 25, 2006

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